

PATENT COOPERATION TREATY

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From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

To:

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Akte / Vorg.

Eing. 15. Feb. 2005

☐ WV☐ ablegen☐ verteilen

NOTIFICATION OF TRANSMITTAL OF
THE INTERNATIONAL PRELIMINARY
EXAMINATION REPORT

(PCT Rule 71.1)

Date of mailing
(day/month/year)

14.02.2005

Applicant's or agent's file reference
2002JP318

IMPORTANT NOTIFICATION

International application No.
PCT/EP 03/11614

International filing date (day/month/year)
21.10.2003

Priority date (day/month/year)
01.11.2002

Applicant
CLARIANT INTERNATIONAL LTD et al.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.
4. **REMINDER**

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed inventions is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the international
preliminary examining authority:



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PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 2002JP318	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/EP 03/11614	International filing date (<i>day/month/year</i>) 21.10.2003	Priority date (<i>day/month/year</i>) 01.11.2002
International Patent Classification (IPC) or both national classification and IPC C09D183/16		
Applicant CLARIANT INTERNATIONAL LTD et al.		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 5 sheets, including this cover sheet.

☐ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of sheets.

3. This report contains indications relating to the following items:

I ☒ Basis of the opinion

II ☐ Priority

III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability



IV ☐ Lack of unity of invention

V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

VI ☐ Certain documents cited

VII ☐ Certain defects in the international application

VIII ☐ Certain observations on the international application

Date of submission of the demand 04.05.2004	Date of completion of this report 14.02.2005
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer Kolitz, R Telephone No. +49 89 2399-8481 <div style="text-align: right;">  </div>

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. PCT/EP 03/11614

I. Basis of the report

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

Description, Pages

1-26 as originally filed

Claims, Numbers

1-14 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

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International application No. **PCT/EP 03/11614**

**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement**

1. Statement

Novelty (N)	Yes: Claims	3-5,9,13
	No: Claims	1,2,6-8,10-12,14
Inventive step (IS)	Yes: Claims	
	No: Claims	3-5,9,13
Industrial applicability (IA)	Yes: Claims	
	No: Claims	1-14

2. Citations and explanations

see separate sheet

Re item V:

Reasoned statement with regard to novelty and inventive step and industrial applicability, Article 33 (2) to (4) PCT:

D1: EP0899091A

D2: EP0781815A = JP-A-9-31333

D3: EP0825231A

- 1.1 Lack of novelty of claims 1, 2, 6-8, 10-12 and 14 in the sense of Article 33(2) PCT: D1, for instance example 6 [0169], example 38 [0233] and example 41 [0242] disclose a coating solution comprising 20 wt% or 10 wt% of a polysilazane having a Si-H bond, xylene as a diluting solvent and a catalyst (content of zinc oxide in ex.41: 10 wt%).

Contrary to the statement in your letter of 02 August 2004, D1 example 6, paragraph [169], page 19, lines 3-5 mentions in fact "a xylylene solution of perhydropolysilazane containing a low temperature-curable metal catalyst" viz zinc oxide.

The subject-matter of claim 1 is not novel.

As xylene used as solvent in D1, examples 6, 38 and 41 is an aromatic solvent the subject-matter of claim 2 is not novel.

The concentration of the polysilazane in D1, examples 6 and 38 is 20wt%, see D1, page 6, line 4 and page 26, line 17 "solid content 20wt%" and in D1 example 41 it is 10%. The subject-matter of claims 6 and 7 is not novel.

The content of zinc oxide in example 41 is 10 wt%, see D1, page 26, line 57. The subject-matter of claim 8 is not novel.

D1 refers in [0112] to JP-A-9-31333 = D2. EP0781815A, which discloses in its reference examples 1-3 exactly the methods of synthesis disclosed in present claims 10 and 11. As mentioned e.g. in the above cited examples, it is used as a surface coating of a base material to enhance abrasion resistance as defined in present claim 12 and the surface has been coated before with another coating (lacquer/varnish or paint) as defined in present claim 14, see also [0013]-[0015]. The subject-matter of present claims 1, 2 6-8, 10-12 and 14 is not novel.

- 1.2. The same applies to D3 examples 9-12, which discloses a coating solution comprising a 20% b.wt.. of a polysilazane having a Si-H bond in dibutylether

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International application No. PCT/EP 03/11614

(coating solution A), and a n-pentyl amine catalyst. The subject-matter of present claims 1, 2, 6-8 is not novel vis -à- vis D3.

2. Lack of inventive step of the subject-matter of claims 3-5, 9 and 13 in the sense of Article 33(3)PCT.

As xylene is used as solvent in D1, examples 6, 38 and 41, it is more than obvious to use it as a further solvent as in present claim 5.

D1 lists in paragraph [0119] as solvents all the hydrocarbons being present in mineral spirits as disclosed in present claim 3 and (di)ethylether, dimethyldioxane (a polyglycolether), or tetrahydrofuran as disclosed in present claim 4.

Moreover D1 lists in paragraph [0123] as catalysts all the catalysts disclosed in present claim 9. The subject-matter of claims 3-5 and 9 appears to be obvious.

Although not mentioned in D1 the use of the coating solution in combination with a primer as defined in present claim 13 appears at first glance obvious.

The subject-matter claims 3-5, 9 and 13 is therefore not inventive in the sense of Art. 33(3)PCT.

3. The subject-matter of claims 1-14 appears to be industrially applicable in the sense of Article 33(4) PCT.